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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1928.

No. 74

ARTHUR E. COLGATE, Administrator of the Estate of Clinton G. Colgate, Deceased, Petitioner,

v.

THE UNITED STATES.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CLAIMS.

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LOUIS TITUS,
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(34,178)

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1928.

No. 869.

ARTHUR E. COLGATE, ADMINISTRATOR OF THE ESTATE OF CLINTON G. COLGATE, DECEASED, Petitioner,

v.

THE UNITED STATES.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CLAIMS.

To the Honorable the Supreme Court of the United States:

The petition of Arthur E. Colgate, Administrator of the Estate of Clinton G. Colgate, deceased, respectfully represents:

Your petitioner prays for a writ of certiorari to review a final judgment of the Court of Claims of the United States, rendered in this case on February 4, 1929, dismissing a petition of the petitioner praying

for a judgment in the sum of $50,000 against the United States, the claim against the United States arising out of the use by the United States, without a license, of a certain patented device for insulating submarine cables, which belonged to the estate of Clinton G. Colgate, deceased.

On March 3, 1927, Congress passed an act which reads as follows (44 Stat., Part III, p. 1807):

> "CHAP. 408.—*An Act for the Relief of Arthur E. Colgate, Administrator of Clinton G. Colgate, Deceased.*
>
> "*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, against the United States, Congressional, Numbered 6063, Senate Document Numbered 703, Sixty-fourth Congress, second session, be, and they are hereby, referred back to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require: *Provided,* That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment: *Provided further,* That the amount of any such judgment shall not exceed the sum of $50,000: *And provided further,* That such notice hereof shall be given to the Attorney General of the United States as may be provided by orders of said court, and it shall

be the duty of the Attorney General to cause one of his assistants to appear and defend for the United States."

"Approved, March 3, 1927."

In pursuance of this act, petitioner filed his petition in the Court of Claims on May 4, 1927. As appears by the above act, the case had been previously before the Court of Claims, and that court had made and reported to Congress its Findings of Fact in said case. On February 4, 1929, the Court of Claims entered the same Findings of Fact as it had previously reported to Congress, and thereupon entered a judgment dismissing the petition.

These findings show that, beginning in 1848, George B. Simpson filed in the Patent Office a number of successive applications for patent for a device for insulating submarine cables by a covering of gutta-percha. These applications continued at intervals until 1866, when the final application was filed upon which the patent was issued May 21, 1867.

On January 15, 1851, Simpson wrote the Commissioner of Patents a letter withdrawing his application for patent and requesting the refund of his fee of $20. He renewed the application December 24, 1858, for substantially the same invention. After many further rejections and new applications the patent was finally issued May 21, 1867.

By mesne conveyances title to the Simpson patents became vested November 15, 1877, in Clinton G. Colgate, the intestate of the present petitioner (Finding VII).

Two decisions of the United States Circuit Court for the Southern District of New York are by reference made a part of Finding V—*Colgate* v. *Western Union Telegraph Co.*, 15 Blatchford, 365, Fed. Case No. 2995, and *Colgate* v. *Gold and Stock Telegraph Co.*, 16 Blatchford, 503, Fed. Case No. 2991. Both of these decisions are by Circuit Judge, later Mr. Justice, Blatchford, and elaborately discuss the history of the invention and its progress through the Patent Office, as well as the prior state of the art. These unequivocally upheld the patent in question and awarded an injunction and damages against the two corporations, respectively, involved.

There are two later opinions reported in the case against the Western Union Telegraph Company, one, Fed. Case No. 2994, decided October 27, 1879, also by Judge Blatchford, granting an attachment for violation of the injunction, the other, in 19 Fed. 828, decided April 4, 1884, by Circuit Judge Wallace, being a petition for rehearing on the ground of a newly discovered letter of January 15, 1851, withdrawing the application for patent and requesting refund of the fee of $20. This petition was denied on the ground, among others, that the existence of such letter was known at the time of the argument before Judge Blatchford in 1878.

In addition to the decision of Judge Blatchford of July 22, 1879, in *Colgate* v. *Gold and Stock Telegraph Co.*, 16 Blatchford, 503, Fed. Case No. 2991, he also, in Fed. Case No. 2992, decided October 27, 1879, granted an attachment against the company and its president for violation of the decree.

The patent was also sustained in *Colgate* v. *International Ocean Telegraph Co.*, 17 Blatchford, 308, Fed. Case No. 2993, decided November 15, 1879, by Judge Blatchford, and in *Colgate* v. *Compagnie Francaise du de Paris a New York*, 23 Fed. 82, decided January 30, 1885, by Circuit Judge Wallace.

The United States then brought a suit to cancel the patent, *United States* v. *Colgate*, 21 Fed. 318, decided August 9, 1884, by District Judge Wheeler, in which he denied a preliminary motion to restrain Colgate from prosecuting suits for infringement, and finally in the same cause (32 Fed. 624), decided December 11, 1884, Circuit Judge Wallace, on hearing on demurrer, the demurrer was sustained and the bill dismissed.

In all these cases the validity of the patent was upheld.

After the decision against the Western Union Telegraph Co., the company paid $100,000 for all past infringements and a schedule of license fees was established for the future, and similar agreements were made with other parties desiring to use the patented invention (Finding VIII).

The Government by its Signal Service and Weather Bureau has used submarine cables consisting of metallic wires employed as conductors of electricity encased with gutta-percha as an insulating agent between 1873 and 1883, and by applying the rates fixed in the schedules named above the claimant would have been entitled to $50,000 for such use (Finding IX).

On these findings the Court of Claims held:

1. The repeated decisions sustaining the validity of this patent would be conclusive on the court on the same state of facts presented to the United States Circuit Court for the Southern District of New York.

2. As, however, the letter of January 15, 1851, withdrawing the application and requesting refund of the fee of $20 was not before Judge Blatchford at the time of his decisions in 1878 and 1879, but only the letter of January 13, 1851, which requested a refund of the $20 without withdrawing the application, they held that the withdrawal of the application by letter of January 15, 1851, constituted a fatal bar to the validity of the patent or to the maintenance of this claim, and therefore dismissed the petition.

Your petitioner therefore prays for the issuance of a writ of certiorari to review the judgment of the Court of Claims on the following grounds:

1. The act of Congress directs the Court of Claims "to render judgment as the findings of fact heretofore found and the law require." It also provides for an appeal to this Court. This last provision indicates the intent of Congress that there should be a review by this Court. If not allowable by appeal, it should be granted by writ of certiorari.

2. The patent herein involved was sustained by the United States Circuit Court for the Southern District of New York in every suit in which its validity was brought in question. These suits were all by Clinton

G. Colgate, the intestate under whom petitioner claims. All of them were against corporate infringers with the exception of one, which was by the United States as plaintiff against Colgate to cancel the patent. In all of them Colgate prevailed.

The judgment of the Court of Claims in this case is the first and only decision of any Federal court against the validity of the patent. This creates a conflict of decision between Federal courts on the same patent which should be settled by this Court.

A question of public interest is involved, because it is always to the public interest that the United States should pay its just obligations, that an act of Congress providing for the examination and recognition of such obligations should have full force and effect, and that the validity and construction of patent rights by the courts of the United States should be uniform.

The opinion and judgment of the Court of Claims are in conflict with the principles of *stare decisis* in failing to follow the decisions of the Circuit Court of the United States for the Southern District of New York in upholding the patent in suits by Colgate against various corporate infringers. It is also in conflict with the principle of *res judicata* in failing to give full force and effect to the decision of said United States Circuit Court in the suit against Colgate to cancel the patent, which suit was on demurrer thereto dismissed.

4. The decision of the Court of Claims holding that the letter withdrawing the application for patent and

requesting the Commissioner of Patents to refund the fee of $20 invalidates the patent is a departure from settled principles of the law of patents as laid down by this court, to wit, in *Godfrey* v. *Eames,* 1 Wallace, 317; *Overland Motor Co.* v. *Packard Motor Co.,* 274 U. S. 417, and other cases.

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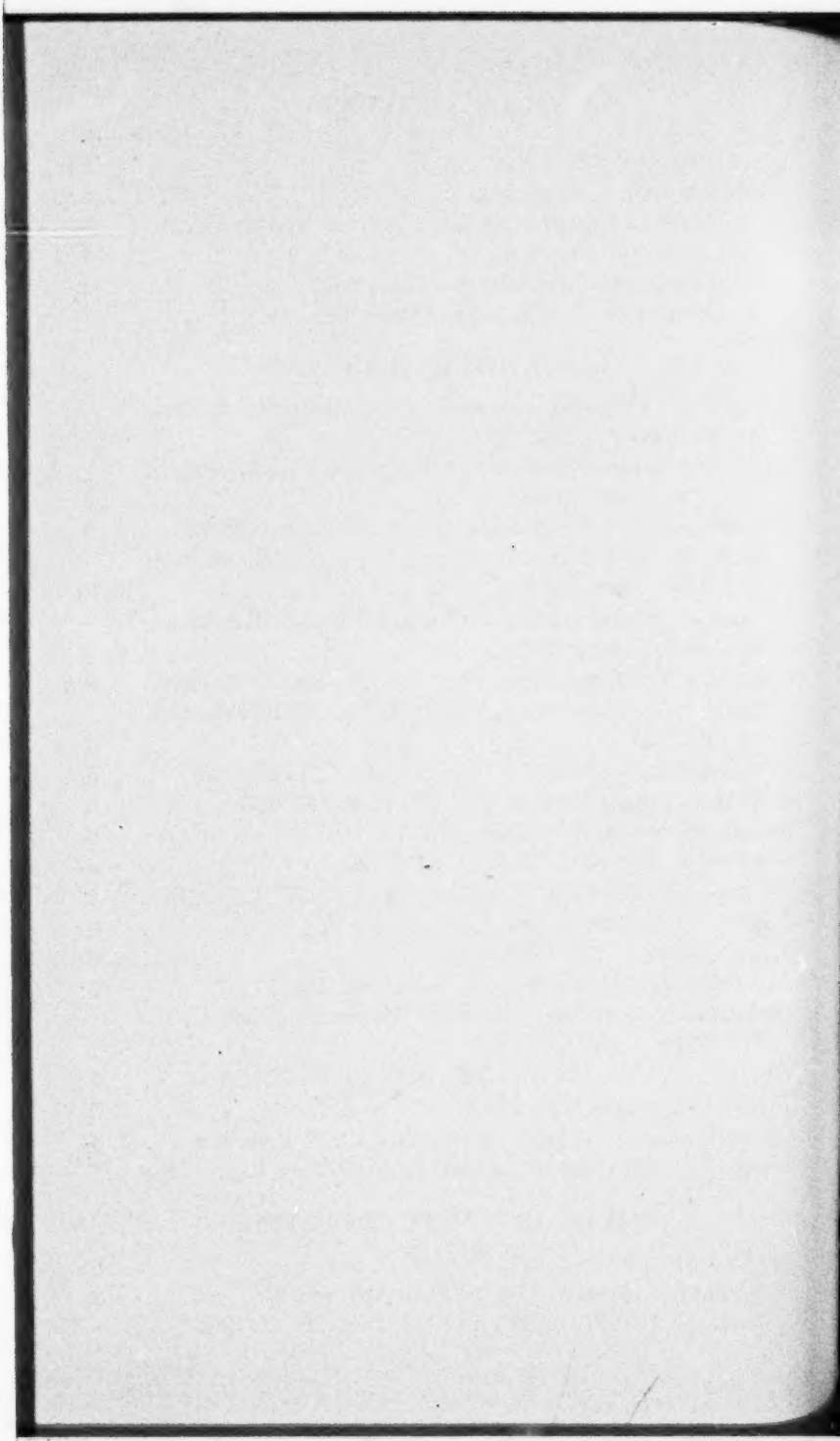

Supreme Court of the United States.

October Term, 1928.

ARTHUR E. COLGATE, Administrator of the Estate of CLINTON G. COLGATE, Deceased, *Petitioner*,
v.
THE UNITED STATES.

No. 869.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

STATEMENT OF THE CASE.

This case came before the Court of Claims by virtue of the following act (44 Stat. Part III, p. 1807):

"Chap. 408. An Act for the relief of Arthur E. Colgate, administrator of Clinton G. Colgate, deceased.

"*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, against the United States, Congressional, Numbered 6063, Senate Document Numbered 703, Sixty-fourth Congress, second session, be, and they are hereby referred back to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require: *Provided*, That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment; *Provided further*, That the amount of any such judgment shall not exceed the sum of $50,000: *And provided further*, That such notice hereof shall be given to the Attorney General of the United States as may be provided by orders of said court, and it shall be the duty of the Attorney General to cause one of his assistants to appear and defend for the United States.

"Approved, March 3, 1927."

The Court of Claims made findings of fact (R. 4–10) identical with those previously entered under the Congressional reference referred to in the special act, the reference having been under the terms of the Bowman Act, March 3, 1883, c. 116, 22 Stat. 485, sec. 1, "An Act to afford assistance and relief to Congress and the executive departments in the investigation of claims and demands against the government."

The validity of the patent had been sustained in a large number of suits, two of which are referred to in Finding V, *Colgate* v. *Western Union Telegraph Co.*, 15 Blatchford, 365, Fed. Case #2995, and *Colgate* v. *Gold and Stock Telegraph Co.*, 16 Blatchford, 503, Fed. Case #2991 (R. 7). Others are referred to in the opinion of the court (R. 13). One of them was an unsuccessful suit brought directly by the United States against Colgate to repeal the patent, *United States* v. *Colgate*, 22 Blatch. 412, 21 Fed. 318, 32 Fed. 624, 127 U. S. 792.

The Court of Claims concedes that the case would be governed by these decisions but for a letter of Simpson, the original inventor, dated January 15, 1851, to the Commissioner of Patents, withdrawing his application for patent. On this sole ground the Court of Claims decides against the claim and dismisses the petition (R. 13–16).

It appears, however, by a subsequent decision, April 4, 1884, in the same case against the Western Union Telegraph Company, 22 Blatch. 118, 19 Fed. 828, decided by Circuit Judge Wallace, that this same letter was presented to him in the same court and in the same case in support of an application for rehearing of the case, and that he refused the rehearing on the very ground, among others, that the letter was known to counsel at the time of Judge Blatchford's original decision in Colgate's case against the telegraph company in 1878. (See quotation from Judge Wallace's opinion in the opinion of the Court of Claims, R. 15.)

At a still later date, December 11, 1884, the U. S. Circuit Court, by Judge Wallace, dismissed on demurrer a bill by the United States to cancel the patent. *United States* v. *Colgate*, 32 Fed. 624. This was at a time when the existence of this letter of abandonment was well known.

The following are the reported decisions of that court as

referred to either in Finding V (R. 7) or in the opinion of the court (R. 13), or both.

Colgate v. *Western Union Telegraph Co.*, 15 Blatchford, 365, Fed. Case #2995, decided November 26, 1878: Full discussion of patent by Judge Blatchford; invention sustained against alleged anticipation; also holding it infringed by the Western Union Telegraph Company and decreeing that the plaintiff have an injunction and an accounting with costs.

Colgate v. *Gold and Stock Telegraph Co.*, 16 Blatch. 503, Fed. Case #2991, decided July 22, 1879, by Blatchford, Circuit Judge, again sustained validity of patent, with particular reference to newly introduced German publications of 1847; holding that Simpson was the first inventor and that Colgate as his assignee is entitled to an injunction and accounting.

Colgate v. *Western Union Telegraph Co.*, Fed. Case #2994, decided October 27, 1879, by Blatchford, Circuit Judge; motion for attachment for violation of injunction previously decreed granted.

Colgate v. *Gold and Stock Telegraph Co.*, Fed. Case #2992, decided October 27, 1879, by Blatchford, Circuit Judge: Attachment for violation in preceding case (Fed. Case #2991) granted against the company and its president.

Colgate v. *International Ocean Telegraph Co.*, 17 Blatch. 308, Fed. Case #2993, decided November 15, 1879, by Blatchford, Circuit Judge: Validity of patent sustained. Held infringed by international cable between the shores of Florida and Cuba. Injunction and accounting granted.

Colgate v. *Western Union Telegraph Co.*, 22 Blatch. 118, 19 Fed. 828, decided April 4, 1884, by Wallace, Circuit Judge: Petition for rehearing on the ground of newly discovered letter of January 15, 1851, showing withdrawal of application for patent, denied on the ground, among others, that the existence of such letter was known to counsel for both parties at the time of the hearing before Judge Blatchford in 1878.

United States v. *Colgate*, 22 Blatch. 412, 21 Fed. 318, decided August 9, 1884, by Wheeler, District Judge: Bill by the United States to repeal the Simpson patent. Preliminary motion to restrain Colgate from prosecuting suits for infringement denied.

United States v. Colgate, 32 Fed. 624, decided December 11, 1884, by Wallace, Circuit Judge: Same suit on hearing on demurrer to bill. Demurrer sustained and bill dismissed unless within twenty days the United States moves to amend, which was not done and the bill was therefore dismissed.

Colgate v. *Compagnie Francaise Du Telegraphe De Paris a New York*, 23 Fed. 82, decided January 30, 1885, by Wallace, Circuit Judge: Bill for infringment of Simpson patent again sustained.

United States v. *Colgate*, 127 U. S. 792, appeal from decree of dismissal of bill to repeal the Simpson patent, 32 Fed. 624. Appeal dismissed by the Solicitor General April 2, 1888.

(This appeal is not mentioned in the findings or opinion of the Court of Claims.)

Thus decisions were rendered in favor of Colgate both in his own suit against the Western Union Telegraph Company and in a suit brought by the United States against Colgate to repeal the patent after the existence of the letter of January 15, 1851, had become known.

The Court of Claims, however, held that the existence of that letter of withdrawal was fatal to the validity of the patent and to the maintenance of this claim against the United States and thus dismissed the petition (R. 16).

Grounds for Certiorari.

1. *Intent of Congress to Allow Review by This Court.*

The act of Congress directs the Court of Claims "to render judgment as the findings of fact heretofore found and the law require." It also provides for an appeal to this court. This last provision indicates the intent of Congress that there should be a review by this court. If not allowable by appeal, it should be granted by writ of certiorari.

2. *Conflict of Decision.*

The conflict of decision between the United States Circuit Court for the Southern District of New York and the Court of Claims in the present case is alone sufficient to warrant the issuance of a writ of certiorari.

Here, in no less than nine reported cases of the Circuit Court of the United States for the Southern District of New York, Finding V (R. 7) and opinion (R. 13), summarized, *ante*, pp. 2, 3, 4, that court sustained the validity of the Simpson patent and the title of Colgate thereto.

These decisions were rendered by Circuit Judge Blatchford, later a Justice of this court, Circuit Judge Wallace, and District Judge Wheeler. Two of them were rendered in a suit by the United States directly against Colgate to repeal the patent. The existence of Simpson's letter of January 15, 1851, withdrawing his application for patent was certainly known in the later stages of the litigation. According to Judge Wallace's decision of April 4, 1884, 19 Fed. 828, it was also known to counsel for both parties at the time of the original hearing before Judge Blatchford in 1878.

Examination of the transcript of record on the appeal in *United States* v. *Colgate*, 127 U. S. 792, shows that Simpson's letter of January, 1851, withdrawing his patent was set up in the bill of complaint of the United States (p. 6 of printed record in No. 198, October Term, 1887).

A conflict between nine decisions of the Circuit Court of the United States for the Southern District of New York, all holding one way, and the decision of the Court of Claims in the present case, holding the other way, on the same patent presents the strongest possible ground for the issuance of a writ of certiorari to correct such a glaring contradiction in decisions.

This is a recognized ground for review of patent cases by this court on writ of certiorari as shown by the following recent cases: *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, 179; *Milburn Co.* v. *Davis Co.*, 270 U. S. 390, 399; *Temco Co.* v. *Apco Co.*, 275 U. S. 319, 322; *Corona* v. *Dovan Corporation*, 276 U. S. 358, 365 and *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U. S. 245, 247.

During the entire time covered by the decisions referred to—1878 to 1888—an appeal lay directly from a United States Circuit Court to this court. Revised Statutes, Sec. 699, paragraph First, in force at the time, provides for an appeal "from any final decree in equity, without regard to the sum or value in dispute" "in any case touching patents-rights or copy-